



UNITED STATES PATENT AND TRADEMARK OFFICE

mn
UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/720,728	11/24/2003	Louis M. Franco	3568/7Cont.	2759
29858 7590 07/27/2007 THELEN REID BROWN RAYSMAN & STEINER LLP 900 THIRD AVENUE NEW YORK, NY 10022			EXAMINER ENG, DAVID Y	
			ART UNIT 2155	PAPER NUMBER
			MAIL DATE 07/27/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/720,728	FRANCO ET AL.	
	Examiner	Art Unit	
	DAVID Y. ENG	2155	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The active claims are 3-40.

The Examiner would like to thank the Applicants for identifying the support of the claims in the specification.

Double Patenting

Claims 1-26 of patent # 6,687,745 contain every element of claims 3-40 of the instant application and as such anticipate claims 3-40 of the instant application.

"A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or **anticipated by**, the earlier claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). " **ELI LILLY AND COMPANY v BARR LABORATORIES, INC.**, United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

In the communication filed on 7/12/2007, Applicants state that a Terminal Disclaimer was submitted with the communication. However, no such Terminal Disclaimer is found in the communication. The double patenting rejection therefore is maintained.

Art Unit: 2155

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 17-30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Although the preamble of independent claim 17 calls for a computer readable medium, the claim combination recites computer program codes. Program is not one of the statutory subject matter.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent claims 3 and 17 fail to identify whether client or host performs the respective steps. Further, there is no functional relationship between the steps because steps are missing. See claim 3 for example. The second step is not functionally related to the first step because the step of sending the retrieved computer program codes from the application server to the clients and the step of executing the computer program codes by the client so as to establish communication between the clients and the application server are missing.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over LeMole (USP 6,009,410) in view of either Moshfeghi (USP 6,076,166) or Eguchi (USP 7,206,085).

Claims 3, 17, 31 35

With respect to independent claims 3, 17, 31 and 35, LeMole teaches:

A method for presenting an application (advertisement or information about Disney, Delta Airlines or Dell Computer and programs for ordering tickets or computers, etc.) in a networked computer processing system (Figure 1) having a plurality of client computers (101, see lines 28 et seq. of column 3) and a plurality of host computers (121, 116 etc.), the method comprising:

Retrieving, in response to a request of a client computer, a content item having computer program code embedded therein, execution of the embedded computer program code establishing a communication connection to a host computer (a click on an access icon, see the first sentence of the abstract);

sending operating environment information regarding the client computer from the client computer to the host computer (user profile, see the second sentence in the abstract);

retrieving presentation information to present an application and content, the presentation information being based on the operating environment information and comprising at least one of instructions for rendering components of the application, default parameters and data values exhibited within the components, and application-specific business logic for processing input to the presented application (retrieving the composite advertising page);

presenting, at the client computer, the application and the content based upon the presentation information (see the rest of the abstract specially the last sentence in the abstract).

The only difference is that In LeMole operating environment information regarding the user (user profile) and not operating environment information regarding the client computer (the capabilities of the client computer) is sent from the client computer to the host computer (server). Sending client capabilities from the client to the server is well known in the art.

Teaching of Eguchi

See at least column 1 lines 29-31 of Eguchi. Eguchi teaches transmitting the client capability from a client to a server. From the teaching of Eguchi it would have been obvious to a person of ordinary skill in the art to transmit the client capability from a client to a server such that services or application sent from the server to the client could be tailored to the capabilities of the client.

Teaching of Moshfeghi

Art Unit: 2155

In column 4 lines 39-42 and 61-65, Moshfgehi teaches that the capabilities of a client is transmitted from the client to a server. Moshfgehi further defined what client capabilities are in column 1 lines 42-58, column 2 lines 58-63 and column 3 lines 1-49. From the teaching of Moshfgehi it would have been obvious to a person of ordinary skill in the art to transmit the client capability from a client to a server such that services or application sent from the server to the client could be tailored to the capabilities of the client.

Claim 4

In regard to claim 4, user clicks the access icon again. See the first sentence of the abstract.

Claim 5

In claim 5, drag and drop is inherent in Window.

Claims 6 and 8-11

As to claims 6 and 8-11, see step 301 in Figure 2 of LeMole.

Claim 7

As to claim 7, Figure 2 of LeMole shows icons associated with labels.

Claim 12-13

As to claims 12-13, it is well known that transmission can be tracked by cookies.

Claims 14-16

With respect to claims 14-16, see Figure 1 of LeMole.

Claims 18-30, 32-34, 36-40

As to claims 18-30, 32-34 and 36-40, they do not define above the invention claimed in claims 1-16 and therefore are rejected for the same reasons.

Thiabult is cited for the teaching of interactions between a client and a server for establishing communication. See Figure 2.

Mandava is cited for the teaching of applet and servlet.


Applicant's arguments with respect to claims 3-40 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DAVID Y. ENG whose telephone number is 571-272-3984. The examiner can normally be reached on M-F from 8AM to 3PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, SALEH NAJJAR, can be reached on 571-272-4006. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


DAVID Y. ENG
PRIMARY EXAMINER